UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,310	08/06/2001	Charles Han	000004	3087

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EXAMINER
ELAHEE, MD S

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/924,310	HAN ET AL.
	Examiner	**Art Unit**	
	Md S. Elahee	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 February 2006*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-5,9,11-15,18-22 and 27-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-5, 9, 11-15, 18-22 and 27-46* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an amendment filed on 02/16/2006. Claims 1-5, 9, 11-15, 18-22 and 27-35 are pending. Claims 6-8, 10, 16, 17 and 23-26 have been cancelled. Claims 36-46 have been added.

Response to Arguments

2.   Applicant's arguments filed on 02/16/2006 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 29-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson (U.S. Patent No. 5,802,149).

        Regarding claims 29, 38-40, Hanson teaches receiving a voice tag corresponding to a first telephone number, the spoken word having a recording quality (fig.2, item 204; col.3, lines 59-67); (Note: the recording quality is inherent here)

comparing inherently the recording quality to a quality parameter (col.3, lines 59-67);

prompting a user to re-record the voice tag when the recording quality does not satisfy the quality (fig.2, item 224);

storing [i.e., saving] the voice tag (fig.2, item 206);

matching [i.e., checking] whether the voice tag is a first voice tag to be save (fig.2, item 210); and

informing the user of an option to use voice dialing if the voice tag is the first voice tag to be saved (fig.3, item 248; col.4, lines 46-49).

Regarding claims 30, 34, Hanson teaches prompting the user audibly (col.3, lines 28-30, col.4, lines 48-49).

Regarding claims 31, 35, Hanson teaches that prompting step comprises presenting text on a personal computer [i.e., LCD display] (col.4, lines 61-67).

Regarding claims 32, 37, Hanson teaches a step of saving the first telephone number before the step of receiving (col.3, lines 59-61).

Regarding claim 33, Hanson teaches asking the user to utilize a voice dialing feature (fig.3, item 248; col.4, lines 46-49).

Regarding claim 36, Hanson teaches matching [i.e., checking] whether a first voice tag corresponding to any telephone number has already been saved (fig.2, item 210);

providing a user with a first prompt for guidance when the first voice tag has not already been saved (fig.2, item 218); and

prompting the user with a second prompt for a second voice tag corresponding to a first telephone number when the first voice tag has already been saved (fig.3, item 238; col.4, lines 34-38).

Regarding claim 41, Hanson teaches ending an operation of prompting for voice dialing if the new voice tag is not the first voice tag to be successfully saved (fig.2, item 218).

Regarding claim 42, Hanson teaches checking whether a voice tag saving or voice dialing feature [i.e., feature] of the wireless communication device has previously been utilized (fig.2, item 208);

providing a user with a first prompt for guidance when the feature of the wireless communication device has not previously been utilized (fig.2, item 218) (Note; since the voice tag does not match with stored voice tag, it is clear that the feature for saving/dialing the voice tag has not previously been utilized, therefore the system prompts the user for guiding whether the user would like to get directory assistance); and

prompting the user with a second prompt for using the feature when the feature of the wireless communication device has previously been utilized (fig.3, item 248).

Regarding claim 43, Hanson teaches that the first prompt for guidance is for making the user aware of the feature (fig.2, item 208; col.4, lines 5-10).

Regarding claim 44, Hanson teaches that the feature is selected from the group consisting of a number saving feature, a voice tag saving feature, a speed dialing feature, and a voice dialing feature (fig.2, item 206, fig.3, items 242,246,248).

Regarding claim 45, Hanson teaches matching [i.e., checking] whether a first voice tag dialing/saving feature [i.e., first feature] wireless communication device his previously been utilized (fig.2, item 210);

prompting a user [i.e., informing a user of an option] to use a second feature if the first feature of the wireless communication device has previously been utilized (fig.3, item 238; col.4, lines 34-38).

Regarding claim 46, Hanson teaches ending an operation of prompting for the second feature if the first feature of the wireless communication device has previously been utilized (fig.2, item 218).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

7.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   Claims 1-5, 9, 11, 13, 14, 18-22 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (U.S. Patent No. 5,802,149) in view of Foladare et al. (U.S. Patent No. 5,978,671).

Claim 1, 11, 18 are rejected for the same reasons as discussed above with respect to claim 29. Furthermore, Hanson fails to teach incrementing a variable indicating a number of calls received from the first telephone number. Foladare teaches incrementing a value [i.e., variable] indicating a number of calls received from the first telephone number (fig.2; col.5, lines 40-42, col.6, lines 38-47). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hanson to incorporate incrementing a variable indicating a number of calls received from the first telephone number in order to determine a repeat caller.

Claims 2, 3, are rejected for the same reasons as discussed above with respect to claims 30, 32, simultaneously.

Regarding claims 4 and 21, Hanson teaches that the threshold number is set by a manufacturer (col.3, lines 63-67). (Note: Since, the number of calls can be fixed in the system, it is clearly refers to the threshold number that is set by a manufacturer)

Regarding claims 5 and 22, Hanson teaches that the threshold number is set by the subscriber (col.3, lines 63-67).

Regarding claims 9 and 15, Hanson teaches saving the voice tag corresponding to the first telephone number in a voice-dialing directory [i.e., voice tag file] (fig.3, item 246).

Regarding claim 13, Hanson teaches prompting [i.e., making a request] audibly (col.3, lines 28-30, col.4, lines 48-49).

9.   Claims 1-5, 11, 13, 14, 18-22, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. Patent No. 5,978,671) in view of Landell et al. (U.S. Patent No. 4,994,983).

Regarding claim 1, Foladare teaches receiving an incoming call from a first telephone number (fig.1, 2; col.5, lines 40-42);

incrementing a value [i.e., variable] indicating a number of calls received from the first telephone number (fig.2; col.5, lines 40-42, col.6, lines 38-47);

prompting a subscriber [i.e., user] to enter [i.e., save] the first telephone number along with a corresponding spoken word [i.e., voice tag] when the value is equal to or greater than a threshold number (fig.2; col.4, lines 38-43, col.6, lines 16-19, 24-34, 38-47). (Note: since the alphanumeric identifier includes the ANI information, it is clear that the subscriber is entering

the telephone number of the caller and since the alphanumeric identifier includes the ANI information, spoken word, it is clear that the spoken word is corresponding to the telephone number);

checking whether a first voice tag corresponding to any telephone number has already been saved (col.7, lines 35-38);

providing the user with guidance when the first voice tag corresponding to any telephone number has not already been saved (col.7, lines 38-45);

prompting the user with a second prompt for a second voice tag corresponding to the first telephone number when the first voice tag corresponding any telephone number has already been saved (col.7, lines 38-44);

Foladare further teaches storing the first telephone number (col.6, lines 31-34).

However, Foladare does not specifically teach "prompting the user with a third prompt for a new voice tag if a recording quality of the corresponding voice tag does not satisfy a quality parameter" and "storing an acceptable recording quality voice tag". Landell teaches prompting the user a third prompt for a new phrase [i.e., voice tag] if a recognition [i.e., recording] quality of the corresponding phrase does not satisfy a quality parameter and updating [i.e., storing] an acceptable recognition quality phrase (col.7, line 54- col.8, line 13, lines 35-44). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foladare to incorporate prompting the user a third prompt for a new voice tag if a recording quality of the corresponding voice tag does not satisfy a quality parameter as well as storing an acceptable recording quality voice tag as taught by Landell. The motivation for the modification is to have doing so in order to provide spoken phrase without having any noise.

Regarding claim 2, Foladare teaches audibly prompting the subscriber (col.6, lines 16-19, 38-41). (Note: audibly prompting is inherent here)

Regarding claims 3 and 14, Foladare teaches that prompting step comprises presenting text on a display 22 [i.e., LCD display] (fig.1; col.4, lines 63-66).

Regarding claims 4 and 21, Foladare teaches that the threshold number is set by a manufacturer (col.8, lines 49-52). (Note: Since, the number of calls can be fixed in the system, it is clearly refers to the threshold number that is set by a manufacturer)

Regarding claims 5 and 22, Foladare teaches that the threshold number is set by the subscriber (col.8, lines 49-52).

Claim 11 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Foladare teaches matching [i.e., comparing] the voice tag to a quality parameter (col.7, lines 5-10, 33-38). (Note: quality parameter is inherent here)

Regarding claim 13, Foladare teaches prompting [i.e., making a request] audibly (col.6, lines 16-19, 38-41). (Note: audibly is inherent here)

Claim 18 rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Foladare teaches a receiver configured to receive an incoming call from a first telephone number (fig.1, 2; col.5, lines 40-42).

a processor [i.e., CPU] configured to increment a value [i.e., variable] indicating a number of calls received from the first telephone number (fig.2; col.4, lines 29-37, col.5, lines 40-42, col.6, lines 38-47).

a user interface adapter configured to prompt a subscriber [i.e., user] to enter [i.e., save] the first telephone number along with a corresponding spoken word [i.e., voice tag] when the value is equal to or greater than a threshold number (fig.1, 2; col.4, lines 38-43, col.6, lines 16-19, 24-34, 38-47). (Note: since the alphanumeric identifier includes the ANI information, it is clear that the subscriber is entering the telephone number of the caller)

a database [i.e., memory] module configured to store the first telephone number (col.6, lines 31-34).

10.   Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. Patent No. 5,978,671) in view of Landell et al. (U.S. Patent No. 4,994,983) further in view of Brady (U.S. Patent No. 5,982,857).

Regarding claims 9 and 15, Foladare teaches saving the voice tag corresponding to the first telephone number (col.6, lines 31-33).

However, Foladare in view of Landell does not specifically teach "saving said voice tag corresponding to said first telephone number in a voice tag file". Brady teaches saving said voice tag corresponding to the first telephone number in a voice tag file (fig.3; col.4, lines 50, 51, col.5, lines 2-11). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foladare in view of Landell to allow saving the voice tag corresponding to the first telephone number in a voice tag file as taught by Brady. The motivation for the modification is to have doing so in order to provide the voice file to store call specific information.

11.   Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Foladare et al. (U.S. Patent No. 5,978,671) in view of Landell et al. (U.S. Patent No. 4,994,983)

further in view of Bambini et al. (U.S. Patent No. 5,898,392).

Regarding claims 12 and 28, Foladare teaches prompting [i.e., making a request] to the

subscriber [i.e., user] to enter [i.e., record] the voice tag in a different location (col.6, lines 31-

34). However, Foladare in view of Landell does not specifically teach "different geographic

location". Bambini teaches different geographic location (col.2, line 63- col.3, line 1). Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Foladare in view of Landell to incorporate different geographic location as taught by

Bambini. The motivation for the modification is to have doing so in order to control the

recording of voice at remote location.

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The

examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the

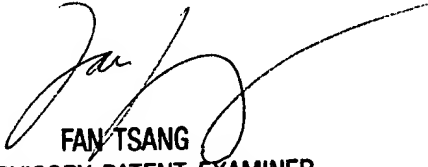organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 12, 2006

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